

### **REMARKS**

In the Office Action, claims 1-19 were pending, and claims 1-19 were rejected. Claim 19 was amended. The amendment does not contain new matter. Support for the amendment is contained in the application as originally filed. Please consider the following remarks.

#### **I. Rejection under 35 U.S.C. §103**

##### **A. Rejection of Claims 1-19 over ("Organo") in view of US Patent No. 3,893,168 ("Brehm") or US Patent No. 2,833,717 ("Whitacre")**

In the Office Action at page 2, number 2, claims 1-19 were rejected under 35 U.S.C. §103(a) as being unpatentable over US Patent No. 6,207,625 ("Organo") in view of US Patent No. 3,898,168 ("Brehm") or US Patent No. 2,833,717 ("Whitacre"). The Examiner stated that Organo fails to teach the use of the claim rust inhibitors. However, the Examiner alleges that it would have been obvious to one of ordinary skill in the art to use a plurality of known anti-rust agents in the composition of Organo based on the teachings of Brehm and Whitacre. Applicants respectfully traverse this rejection.

##### **1. The Present Invention**

The present invention as recited in claim 1 is a lubricating oil composition suitable for use in a four stroke marine engine which comprises an oil of lubricating viscosity containing an admixture of (a) 1 - 3.75 wt.% of an ashless dispersant; (b) a metal detergent; (c) an oil soluble molybdenum compound in an amount sufficient to provide 15 - 1,000 ppm molybdenum in the composition; (d) a zinc dialkyl dithiophosphate in an amount sufficient to provide at least 1,200 ppm phosphorus in the composition; and (e) a rust inhibitor system comprising (i) as a first rust inhibitor, an ethoxylated C<sub>4</sub>-C<sub>18</sub> alkyl phenol having 2-10 moles of ethylene oxide per mole in

combination with a second rust inhibitor selected from the group consisting of (ii) a glycerol ester of a C<sub>8</sub>-C<sub>22</sub> fatty acid, (iii) a half ester of a C<sub>8</sub>-C<sub>22</sub> alkyl or alkenyl succinic acid and a C<sub>2</sub>-C<sub>4</sub> alkylene glycol and (iv) a C<sub>8</sub>-C<sub>22</sub> alkyl or alkenyl succinic acid or anhydride.

## **2. The Cited References**

### **a. Ogano**

Ogano discloses a lubricant oil composition, comprising a base oil composed of a mineral and/or synthetic oil incorporated with at least two types of additives (A) and (B) described below, characterized by being used for diesel engines operating with large quantities of soot in their oil, in particular those equipped with an exhaust gas recirculation (EGR) system: (A) sulfurized oxymolybdenum dithiocarbamate at 0.03 to 0.50 wt % as Mo, based on the whole composition, and (B) zinc dialkyl dithiophosphate at 0.04 to 0.50 wt % as P, also based on the whole composition.

### **b. Brehm**

Brehm discloses a crankcase lubricant oil containing high based magnesium sulfonate and zinc dialkyl dithiophosphate antioxidant-antiwear addition agents. Brehm teaches anti-rust function can be provided by the use of a small amount of polyether addition agent, increasing amount of zinc dialkyldithiophosphate addition agent and decreased amount of higher based magnesium salt of alkyl-substituted benzenesulfonic acid.

### **c. Whitacre**

Whitacre discloses a corrosion inhibiting oil adapted to be used in the lubrication of an internal combustion engine.

### 3. Traversal of the Rejection

For a proper rejection under Section §103, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The present invention as recited in independent claim 1 is a lubricating oil composition for use in a four stroke marine engine comprising a rust inhibitor system comprising (i) as a first rust inhibitor, an ethoxylated C<sub>4</sub>-C<sub>18</sub> alkyl phenol having 2-10 moles of ethylene oxide per mole in combination with a second rust inhibitor selected from the group consisting of (ii) a glycerol ester of a C<sub>8</sub>-C<sub>22</sub> fatty acid, (iii) a half ester of a C<sub>8</sub>-C<sub>22</sub> alkyl or alkenyl succinic acid and a C<sub>2</sub>-C<sub>4</sub> alkylene glycol and (iv) a C<sub>8</sub>-C<sub>22</sub> alkyl or alkenyl succinic acid or anhydride.

In contrast to the present invention as recited in claim 1, Organo is directed to a composition for diesel engines. Specifically, Organo teaches a composition that can efficiently prevent wear of diesel engines operating with large quantities of soot in their oil; particularly diesel engines equipped with an exhaust gas recirculation.

Further, as stated in the Office Action, Organo does not teach or suggest the rust inhibitor system recited in claim 1 of the present invention.

The Examiner goes on to allege the rust inhibitor system of the present invention is taught by the combination of Brehm and Whitacre so a combination of Organo, Brehm and Whitacre encompasses the claimed invention. Unfortunately, the Examiner's allegation is incorrect.

The Examiner's allegation is incorrect for a couple of reasons. The first reason the Examiner's allegation is incorrect relates to the fact Organo is not relevant prior art for the claimed invention. As discussed above, Organo teaches a lubricant oil composition for **diesel engines**. The present invention as recited in claim 1 is a lubricating oil composition for **four stroke marine engines**. One of ordinary skill in the art would not consider a reference teaching a lubricant oil composition for a diesel engine to be prior art for a lubricant oil composition for a four stroke marine engine. Because a four stroke marine engine operates in an environment where there is a lot of water present, a lubricant for a four stroke marine engine must meet different requirements than a lubricant for a diesel engine. Due to the corrosive properties of water, a lubricant for a diesel engine like the one described in Organo would not function properly in a four stroke marine engine. The four stroke marine engine would corrode prematurely if such a composition were used.

Consequently, the Organo reference is not suitable prior art for the invention as claimed. Therefore, the combination of Organo, Brehm and Whitacre is improper and does not negate the patentability of the present invention as recited in claim 1.

The second reason the Examiner's allegation is incorrect relates to the fact the combination of Organo, Brehm and Whitacre does not teach a composition comprising the rust inhibitor system of claim 1. The rust inhibitor system of claim 1 is a specific,

two component system comprising a first rust inhibitor and a second rust inhibitor. The first rust inhibitor is an ethoxylated C<sub>4</sub>-C<sub>18</sub> alkyl phenol having 2-10 moles of ethylene oxide per mole. The second rust inhibitor is either a glycerol ester of a C<sub>8</sub>-C<sub>22</sub> fatty acid; a half ester of a C<sub>8</sub>-C<sub>22</sub> alkyl or alkenyl succinic acid; a C<sub>2</sub>-C<sub>4</sub> alkylene glycol; or a C<sub>8</sub>-C<sub>22</sub> alkyl or alkenyl succinic acid or anhydride.

None of the references cited by the Examiner teach the specific two component rust inhibitor system of the present invention. The Examiner explicitly stated in the Office Action that Organo does not teach or suggest the rust inhibitor system recited in claim 1 of the present invention

Brehm teaches anti-rust function can be provided by use of a small amount of polyether addition agent, increasing amount of zinc dialkyldithiophosphate addition agent and decreased amount of higher based magnesium salt of alkyl-substituted benzenesulfonic acidone. Thus, Brehm teaches the "second rust inhibitor" which can be selected from the group consisting of a glycerol ester of a C<sub>8</sub>-C<sub>22</sub> fatty acid; a half ester of a C<sub>8</sub>-C<sub>22</sub> alkyl or alkenyl succinic acid and a C<sub>2</sub>-C<sub>4</sub> alkylene glycol; and a C<sub>8</sub>-C<sub>22</sub> alkyl or alkenyl succinic acid or anhydride). However, Brehm does not teach the "first rust inhibitor" of the recited rust inhibitor system.

As stated above, the rust inhibitor system recited in claim 1 has a first rust inhibitor comprising an ethoxylated C<sub>4</sub>-C<sub>18</sub> alkyl phenol having 2-10 moles of ethylene oxide per mole. Brehm does not teach this component. The combination of polyether addition agent, increasing amount of zinc dialkyldithiophosphate addition agent and decreased amount of higher based magnesium salt of alkyl-substituted benzenesulfonic acidone as taught by Brehm does not encompass the first rust inhibitor of the present

invention. Because the first rust inhibitor of the present invention is not taught by Brehm, Brehm cannot teach the specific, two component rust inhibitor system as recited in claim 1. Therefore, a combination of Organo and Brehm does not teach or suggest the lubricating oil composition comprising the rust inhibitor made up of the first rust inhibitor and the second rust inhibitor as recited in claim 1.

Like Brehm, Whitacre teaches several difference rust inhibitors. However, also like Brehm, Whitacre does not teach the specific, two component rust inhibitor system as recited in claim 1. Therefore, the combination of Organo and Whitacre does not teach or suggest the lubricating oil composition comprising the rust inhibitor made up of the first rust inhibitor and the second rust inhibitor as recited in claim 1.

The Examiner would have us believe that it is proper to pick and choose from the various rust inhibitors taught in Brehm and Whitacre to come up with the rust inhibitor system recited in claim 1. By doing so, the Examiner would have us follow an "obvious to try" standard which is not the law. See In re Fine, 837 F.2d 1071, 1075 (Fed. Cir. 1988). In this case, the specific rust inhibitor system of the invention enables a low treat rate which is not possible with other combinations of known rust inhibitors.

For the reasons discussed above, Organo, Brehm and Whitacre, either alone or in combination, do not teach or suggest all the claim limitations in claim 1 of the present invention as required for a proper rejection under Section 103. Specifically, (1) Organo is not prior art and (2) the references do not teach or suggest the rust inhibitor system comprising the first rust inhibitor and the second rust inhibitor as recited in claim 1. As a result, Applicants respectfully request that the Examiner withdraw the rejection of claim 1 over Organo in view of Brehm and Whitacre.

Claims 2-19, directly or indirectly, depend from claim 1 of the present invention and recite the invention in varying scope. For the reasons discussed above, Organo, Brehm and Whitacre, either alone or in combination, do not teach or suggest the lubricating oil composition comprising a rust inhibitor made up of (i) as a first rust inhibitor, an ethoxylated C<sub>4</sub>-C<sub>18</sub> alkyl phenol having 2-10 moles of ethylene oxide per mole in combination with a second rust inhibitor selected from the group consisting of (ii) a glycerol ester of a C<sub>8</sub>-C<sub>22</sub> fatty acid, (iii) a half ester of a C<sub>8</sub>-C<sub>22</sub> alkyl or alkenyl succinic acid and a C<sub>2</sub>-C<sub>4</sub> alkylene glycol and (iv) a C<sub>8</sub>-C<sub>22</sub> alkyl or alkenyl succinic acid or anhydride as recited in claim 1 and in varying scope by claims 2-19. As a result, Applicants respectfully request that the Examiner withdraw the rejection of claims 2-19 over Organo in view of Brehm and Whitacre.

**B. Rejection of Claims 1-9 and 11-19 over US Patent No. 6,444,624 ("Walker") in view of US Patent No. 3,876,550 ("Holubec") and further in view of U.S. Patent No. 3,898,168 ("Brehm") or US Patent No. 2,833,717 ("Whitacre")**

In the Office Action at page 4, number 3, claims 1-9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over ("Walker") in view of US Patent No. 3,876,550 ("Holubec") and further in view of U.S. Patent No. 3,898,168 ("Brehm") or US Patent No. 2,833,717 ("Whitacre"). The Examiner stated that Walker fails to disclose the use of the claim rust inhibitors. However, the Examiner alleges that it would have been obvious to one of ordinary skill in the art to use a plurality of known anti-rust agents in the composition of Organo based on the teachings of Holubec, Brehm and Whitacre. Applicants respectfully traverse this rejection.

## **1. The Cited References**

### **a. Walker**

Walker discloses an SAE OW-30 or 5W-30 or 5W-20 lubricant having a Noack volatility of less than 15 and a chlorine content of less than 100 ppm. The lubricant comprises a basestock containing from 0 to less than 10% Group I and/or Group II basestocks, a molybdenum additive providing not greater than 1000 ppm of molybdenum to the lubricant, a calcium detergent providing 10 or greater mmoles of surfactant per kilogram of lubricant, one or more other additives, and a viscosity modifier.

### **b. Holubec**

Holubec discloses lubricant compositions comprising an additive combination comprising an alkylene dithiocarbamate and an aliphatic hydrocarbon-substituted succinic acid or certain derivatives thereof. Holubec teaches an anti-rust component comprising one or more rust inhibitors selected from the group consisting of aliphatic hydrocarbon-substituted succinic acids, aliphatic hydrocarbon-substituted succinic anhydrides and esterified reaction products obtained by the partial esterification of the aliphatic hydrocarbon-substituted acids or their anhydrides with at least one alkylene oxide or alkylene glycol. The partially esterified reaction product is prepared by the esterification of from about 0.1 mole to about 1.0 mole of the alkylene oxide or the alkylene glycol per mole of the aliphatic hydrocarbon-substituted succinic acid or anhydride.

## **2. Traversal of the Rejection**

The rule for a proper rejection under Section 103 is shown above. The present invention as recited in independent claim 1 is a lubricating oil composition **for use in a**



**four stroke marine engine** comprising a rust inhibitor system comprising (i) as a first rust inhibitor, an ethoxylated C<sub>4</sub>-C<sub>18</sub> alkyl phenol having 2-10 moles of ethylene oxide per mole in combination with a second rust inhibitor selected from the group consisting of (ii) a glycerol ester of a C<sub>8</sub>-C<sub>22</sub> fatty acid, (iii) a half ester of a C<sub>8</sub>-C<sub>22</sub> alkyl or alkenyl succinic acid and a C<sub>2</sub>-C<sub>4</sub> alkylene glycol and (iv) a C<sub>8</sub>-C<sub>22</sub> alkyl or alkenyl succinic acid or anhydride.

In contrast to the present invention as recited in claim 1, Walker is directed to a composition for **diesel engines**. Specifically, Walker teaches a multigrade lubricating oil composition that gives enhanced performance in diesel engine ring-sticking tests.

Further, as stated in the Office Action, Walker does not teach or suggest the rust inhibitor system recited in claim 1 of the present invention.

The Examiner goes on to allege the rust inhibitor system of the present invention is taught by the combination of Holubec, Brehm and Whitacre so a combination of Organo, Holubec, Brehm and Whitacre encompasses the claimed invention. Unfortunately, the Examiner's allegation is incorrect.

The Examiner's allegation is incorrect for a couple of reasons. The first reason the Examiner's allegation is incorrect relates to the fact Walker is not relevant prior art for the claimed invention. As discussed above, Walker teaches a lubricant oil composition for a diesel engine. The present invention as recited in claim 1 is a lubricating oil composition for a four stroke marine engine. One of ordinary skill in the art would not consider a reference teaching a composition for a diesel engine to be prior art for a composition for a four stroke marine engine. Because a four stroke marine engine operates in an environment where there is a lot of water present, a lubricant for a

four stroke marine engine must meet different requirements than a lubricant for a diesel engine. Due to the corrosive properties of water, a lubricant for a diesel engine like the one described in Walker would not function properly in a four stroke marine engine. The four stroke marine engine would corrode prematurely if such a composition were used.

Consequently, the Walker reference is not suitable prior art for the invention as claimed. Therefore, the combination of Walker, Holubec, Brehm and Whitacre is improper and does not negate the patentability of the present invention as recited in claim 1.

The second reason the Examiner's allegation is incorrect relates to the fact the combination of Organo, Holubec, Brehm and Whitacre does not teach a composition comprising the rust inhibitor system of claim 1. The rust inhibitor system of claim 1 is a specific, two component system comprising a first rust inhibitor and a second rust inhibitor. The first rust inhibitor is an ethoxylated C<sub>4</sub>-C<sub>18</sub> alkyl phenol having 2-10 moles of ethylene oxide per mole. The second rust inhibitor is either a glycerol ester of a C<sub>8</sub>-C<sub>22</sub> fatty acid; a half ester of a C<sub>8</sub>-C<sub>22</sub> alkyl or alkenyl succinic acid; a C<sub>2</sub>-C<sub>4</sub> alkylene glycol; or a C<sub>8</sub>-C<sub>22</sub> alkyl or alkenyl succinic acid or anhydride.

None of the references cited by the Examiner teach the specific two component rust inhibitor system of the present invention. The Examiner explicitly states in the Office Action that Walker does not teach or suggest the rust inhibitor system recited in claim 1 of the present invention.

Neither Brehm nor Whitacre, for the reasons discussed above, teach the rust inhibitor system recited in claim 1. As a result, the combination of Walker, Brehm and Whitacre does not teach or suggest the lubricating oil composition comprising the rust

inhibitor made up of the first rust inhibitor and the second rust inhibitor as recited in claim 1.

Like Brehm and Whitacre, Holubec teaches several difference rust inhibitors. However, also like Brehm and Whitacre, Holubec does not teach the specific, two component rust inhibitor system recited in claim 1. Specifically, Holubec teaches the "second rust inhibitor" but not the "first rust inhibitor" of the recited rust inhibitor system. Therefore, the combination of Walker and Holubec does not teach or suggest the lubricating oil composition comprising the rust inhibitor made up of the first rust inhibitor and the second rust inhibitor as recited in claim 1.

The Examiner would have us believe that it is proper to pick and choose from the various rust inhibitors disclosed in Holubec, Brehm and Whitacre to come up with the rust inhibitor system as recited in claim 1. By doing so, the Examiner would have us follow an "obvious to try" standard which is not the law. See In re Fine, 837 F.2d 1071, 1075 (Fed. Cir. 1988). In this case, the specific rust inhibitor system of the invention enables a low treat rate which is not possible with other combinations of known rust inhibitors.

For the reasons discussed above, Organo, Holubec, Brehm and Whitacre, either alone or in combination, do not teach or suggest all the claim limitations in claim 1 of the present invention as required for a proper rejection under Section 103. Specifically, (1) Walker is not prior art and (2) the references do not teach or suggest the rust inhibitor system comprising the first rust inhibitor and the second rust inhibitor as recited in claim 1. As a result, Applicants respectfully request that the Examiner withdraw the rejection of claim 1 over Organo in view of Holubec, Brehm and Whitacre.

Claims 2-19, directly or indirectly, depend from claim 1 of the present invention and recite the invention in varying scope. For the reasons discussed above, Walker, Holubec, Brehm and Whitacre, either alone or in combination, do not teach or suggest the lubricating oil composition comprising a rust inhibitor made up of (i) as a first rust inhibitor, an ethoxylated C<sub>4</sub>-C<sub>18</sub> alkyl phenol having 2-10 moles of ethylene oxide per mole in combination with a second rust inhibitor selected from the group consisting of (ii) a glycerol ester of a C<sub>8</sub>-C<sub>22</sub> fatty acid, (iii) a half ester of a C<sub>8</sub>-C<sub>22</sub> alkyl or alkenyl succinic acid and a C<sub>2</sub>-C<sub>4</sub> alkylene glycol and (iv) a C<sub>8</sub>-C<sub>22</sub> alkyl or alkenyl succinic acid or anhydride as recited in claim 1 and in varying scope by claims 2-19. As a result, Applicants respectfully request that the Examiner withdraw the rejection of claims 2-19 over Walker in view of Holubec, Brehm and Whitacre.

## **II. Rejections over US Patent No. 6,642,188**

### **A. Double Patenting Rejection of Claims 1-19 over Claims 1-14 of US Patent No. 6,642,188**

In the Office Action at page 6, number 4, claims 1-19 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of US Patent No. 6,642,188.

Applicants have filed a terminal disclaimer along with this response which overcomes the present rejection. All of the inventors of the present invention and of US Patent No. 6,642,188 were employees of Infineum at the time of the inventions and thus obligated to assign all rights, interests and title in their inventions to Infineum. If necessary, copies of Assignment documents and other can be provided to the Examiner.

**B. Rejection of Claims 1-19 as being not patentably distinct from Claims 1-**

**14 of US Patent No. 6,642,188**

In the Office Action at page 7, number 5, claims 1-19 were rejected as being directed to an invention not patentably distinct from claims 1-14 of commonly assigned US Patent No. 6,642,188.

The Examiner stated that this rejection can be overcome by showing that the conflicting inventions were commonly owned at the time of the invention in this application was made 35 U.S.C. 103(c) and 37 CFR 1.78(c). As stated above, all of the inventors of the present invention and of US Patent No. 6,642,188 were employees of Infineum at the time of the inventions and thus obligated to assign all rights, interests and title in their inventions to Infineum. If necessary, copies of Assignments and other can be provided to the Examiner. In light of the above, this rejection should be withdrawn.

**C. Rejection of Claims 1-19 under 35 U.S.C. §103(a) as being obvious over**

**US Patent No. 6,642,188**

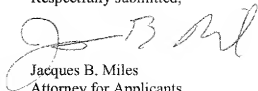
In the Office Action at page 7, number 6, claims 1-19 were rejected under 35 U.S.C. §103(a) as being obvious over US Patent No. 6,642,188. In this specific situation where the earlier-filed and later-filed applications, although they have different inventorship entities, have both been assigned to the same entity and a difference exists between the claims of the two applications which is deemed to be obvious, the issue reduces itself to a question of obviousness double patenting which can be obviated by filing a terminal disclaimer. §§15:51 to 15:59, 15:125.

A terminal disclaimer has been filed along with this response. Therefore, Applicants respectfully request the withdrawal of this rejection.

## VII. Conclusion

Based upon the foregoing, it is submitted that the claimed invention now claimed is in condition for allowance. The Applicants therefore request that the application now be passed to issue.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'J B Miles', is written over the typed name.

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